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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,869	09/21/2000	Thomas Vaughn Wilder	DAREDEV.018RA	4598

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EXAMINER

FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/669,869

Applicant(s)
WILDER, ET AL

Examiner
Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 17, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, and 16-35 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13 6) ☐ Other: _____

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Acknowledgments

1. The Information Disclosure Statement (paper 13) and Amendment (paper 15) filed 12-17-2002 has been entered.

Change of Examiner

2. The Instant Application has been transferred from the Docket of Michael Mar to the Docket of Bryan Fischmann. Mr. Mar is now working in a different area of the Patent Office.

Request for Continued Examination

3. The request filed on 12-17-2002 (paper 14) for a Request for Continuing Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/669,869 is acceptable and an RCE has been established. An action on the RCE follows.

Supplemental Oath/Declaration

4. Note that a Supplemental Oath/Declaration will be required prior to allowance. See Section 1444 of the MPEP.

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Specification

5. The disclosure is objected to because of the following:

A) The following inconsistencies in nomenclature were noted:

1) The last two lines of page 2 recites "lateral sections 36, 37". Lines 7 and 21 of page 3 recites "web sections 36-38".

To avoid confusion to the reader, and to facilitate identifying components by nomenclature in the claims, it is requested Applicant use consistent nomenclature for the same reference number throughout the specification.

Claim Objections

6. Claim 1-5 are objected to because of the following:

A) Claims 1-12 are considered awkwardly worded and unclear due to the following:

1) Lines 6-9 of claim 1 recites "...a pair of laterally spaced longitudinal members, said longitudinal members having generally planar upper portions with upper edges integrally attached to said heel and forefoot attachment members...".

From the above, it is understood that there are a total of four "upper portions", two associated with the heel attachment member and two associated with the forefoot attachment member.

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2) Lines 10-14 of claim 1 then goes on to recite "...one of said upper portions being substantially coplanar with a respective lower portion, the other one of said upper portions being inclined toward the coplanar one of said upper portions...".

This recitation, particularly the words "one of said upper portions" and "the other one of said upper portions", implies that there is only a total of two upper portions, which would seem to contradict the recitation in subparagraph 1), which implies there are a total of four upper portions.

3) Note that the first paragraph of page 2 of the specification recites "The longitudinal members 20, 22 have upper portions 24, 26...". Note that Figures 2 and 3 appear to show that reference number 24 is the "upper portion" associated with each side of the forefoot attachment member and that reference number 26 is the "upper portion" associated with each side of the heel attachment member.

4) Note that from the above, it is considered unclear whether lines 10-14 of claim 1 is intended to refer to "upper portions" associated a single longitudinal member (20 or 22), or a total of two longitudinal members, or whether lines 10-14 of claim 1 is intended to refer to all four upper portions.

Note that if Applicant is referring to upper portions on one side only, that the claim 1 would either appear to "read" on Osbourne US Des. 362,893, see particularly Figures 5 and 6, or come very close to "reading" on this Patent, depending upon how claim 1 is interpreted. Note that Applicant cited this patent on paper 13. It is noted that Osbourne has upper portions

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that “diverge” in an upward direction, while Applicant’s upper portions “converge” in an upward direction. However, note that the use of the word “inclined” in claim 1 does not require “convergence” or “divergence” of the upward portions in an upward direction, as Webster’s Collegiate Dictionary, 10th Edition, defines “incline” as: “to deviate from the horizontal or vertical”. However, if Applicant’s intent was to say that the upper portion was inclined toward an upper portion on the opposite side of the longitudinal centerline of the skate, Osbourne would not “read” on claim 1. From review of the prosecution history, it is best understood that this is the intent of Applicant, so an art (102 or 103) rejection of claim 1 is not being set forth at this time.

Recommend Applicant amend claim 1 to distinctly set forth whether lines 10-14 are directed to 2 total upper portion, or 4 and to clarify that the upper portion is “inclined” relative to another upper portion on the opposite side of the longitudinal centerline of the skate.

B) Claim 1 is also objected to due to the following:

Lines 14-16 of claim 1 recites “...said lower portions...in an upwardly extending direction being substantially parallel to each other...”.

The words “in an upwardly extending direction” in the above recitation are considered redundant, as if the lower portions are “substantially parallel”, then they would be “substantially parallel”, regardless of whether one “viewed” these lines in an “upwardly” or “downwardly” direction.

Note that claims 2-4 are dependant upon claim 1 and therefore are also objected to.

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C) On line 14 of claim 5, the word "member" should be plural. Compare to line 10 of same claim.

Note that claims 6-12 are dependant upon claim 5 and therefore are also objected to.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-8, 10-13 and 16-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over H-200 Design Drawing (reference 17 of paper 13), in view of Osborne, US Patent D362,893 (reference 11 of paper 13) and CCM 1997 Roller Hockey Pricelist (reference 15 paper 13).

H-200 Design Drawing teaches an integrally formed roller skate chassis comprising:

a heel and forefoot attachment member (top horizontal portion of skate frame)

a pair of longitudinally spaced members (vertical portion of skate frame) having upper edges integrally attached to said heel and forefoot members, said longitudinal members having upper and lower generally planar portions (see "end" view at right side of drawing), said upper portions forming substantially convergent planes in an upwardly extending direction (see "end"

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view at right side of drawing), said lower portions forming substantially parallel planes (see “end” view at right side of drawing).

H-200 Design Drawing fails to teach one or more web members below the upper portions and above the lower portions. H-200 Design Drawing is also undated.

However, Osborne teaches a similarly structured skate frame comprising one or more web members below the upper portions and above the lower portions (Figures 5-7). Web members between the upper and lower portions on a skate frame is advantageous in that it provides additional strength, lessening the chance of unwanted temporary or permanent deformation of the skate frame.

Also note that the “cover page” of CCM 1997 Roller Hockey Pricelist (reference 15 paper 13) states that this “pricelist” is effective 7-1-1996 and that page 3, including hand-written notes provided as part of this reference on paper 13 indicate that frame, or “chassis” on H-200 Design Drawing forms a part of at least “Men’s style M-IS1234” skate on page 3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize webs in the skate frame of H-200 Design Drawing, as taught by Osborne and CCM 1997 Roller Hockey Pricelist.

Regarding claim 6, see Figure 7 of Osborne.

Regarding claims 7, 16, 25 and 32, note recitation of “extrusion profile” on H-200 Design Drawing.

Regarding claim 8, note H-200 Design Drawing teaches the material is aluminum.

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Regarding claim 10, see Figure 7 of Osborne.

Regarding claim 11, see Figure 6 of Osborne.

Regarding claim 12, the Examiner takes Official Notice that it is common practice to chamfer edges of parts. Chamfering edges provides enhanced visual appearance on edges, such as the web of a skate frame.

Regarding the recitation of "mount holes" in claim 13, see Figure 4 of Osborne.

Regarding claims 27 and 31, the Examiner takes Official Notice that metal parts are commonly joined by welding. Also note that Section 2144.04 of the MPEP states that it is within the skill level of one of ordinary skill in the art to make integral parts separate. Manufacturing the extruded metal frame, or chassis of H-200 Design Drawing by separate parts which are welded together is advantageous in that the flat portions are easier to manufacture.

Regarding the method of recited in claims 29-35, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the claimed method taught by H-200 Design Drawing (reference 17 of paper 13), as modified by Osborne, US Patent D362,893 (reference 11 of paper 13) and CCM 1997 Roller Hockey Pricelist (reference 15 paper 13). Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be an obvious step in light of the disclosed structure. See MPEP §2112.02. See also *In re King*, 801 F2d 1324, 1326; 231 USPQ 136, 138 (Fed Cir 1986).

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Allowable Subject Matter

9. Claim 9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner's Comments

10. The 103 rejections set forth in this Office Action are as a result of newly cited art on the IDS (paper 13) submitted by Applicant.

11. The Examiner appreciates the courtesy extended by Applicant's representative (Glen Nuttall) in attempting to resolve outstanding issues in this Application by phone. However, as additional issues were uncovered by the Applicant it then became apparent that there were too many outstanding issues to resolve by phone.

12. The claim objections set forth in this Office Action to claim 1 may be overcome by the proposed amendment to claim 1 submitted by Mr. Nuttall. This amendment was not entered into the file wrapper, per Mr. Nuttall's wishes, but the Examiner has retained a copy if needed by Applicant.

13. The Examiner also appreciates the initialed copy of an IDS (paper 7) which was faxed to the Examiner and which was previously missing from the file wrapper. This initialed (by Michael Mar) copy of the IDS has been placed in the file wrapper.

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A) Ohashi - teaches skate with an upwardly converging frame portion (Figure 3)
- B) McNamara, et al - teaches skate with an upwardly inclined frame portion (Figures 4 and 5)
- C) Soo - teaches skate with an upwardly converging frame portion (Figure 3)
- D) Malewicz - teaches skate with an upwardly inclined frame portion (Figure 6)
- E) Monroy, et al - teaches skate with an upwardly converging frame portion (Figures 4 and 5)
- F) Lu - teaches skate with an upwardly converging frame portion (Figures 4 and 5)
- H) Iverson - teaches skate with an upwardly converging frame portion (Figures 6 and 7)
- I) Chetham, et al- teaches skate with an upwardly converging frame portion (Figure 3)
- J) Japanese Patent 4-279182 - teaches skate with an upwardly inclined frame portion (Figure 2)
- K) European Patent 810008 - teaches skate with an upwardly converging frame portion (Figure 2)
- L) SE 2002-178357 - teaches skate with an upwardly converging frame portion

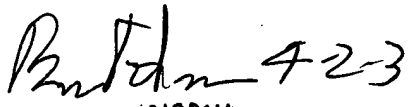
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15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955.

The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


BRYAN FISCHMANN
PATENT EXAMINER